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09/641,030	08/17/2000	Leanne M. Capozzi	81503F-P	4827

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,030

Applicant(s)

CAPOZZI ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 24-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, are drawn to a kit, classified in class 402, subclass 73.
- II. Claims 24 and 45, are drawn to a kit using computer software and a database, classified in class 705, subclass 1.

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III. Claims 25-44, are drawn to a kit having a shipping container, classified in class 206, subclass 223.

IV. Claims 46-48, are drawn to a kit using optically scannable information, classified in class 235, subclass 487.

1. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the kit as disclosed in invention II does not need a form having a code capable for use in organizing images. The subcombination has separate utility such as instructing the user on how to use the kit, whereas the combination provides a computer software product and a database used to organize images.

2. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated since a shipping container (stated in Group III) is not used for a kit for organizing equipment according to Group I.

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3. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the kit in invention II does not require a machine readable code. The subcombination has separate utility such as providing an instruction form having a machine readable code on how to use the kit, whereas the combination uses an instruction form to obtain information on how to organize..

4. Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination requires scanning and converting images by optical character recognition to obtain meta-data instructional information on how to organize. The subcombination has separate utility such as using a computer software product to scan images and place images in a group.

5. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

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inventions are unrelated since Group IV does not disclose the use of a shipping container as disclosed in Group III to hold items.

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated since Group II does not disclose the use of a shipping container.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Attorney Frank Pincelli on March 27, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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***Claim Objections***

10. Claims 15 and 21 is objected to because of the following informalities:

In Claim 15, line 1, it is not understood what is meant by “a pairs of identical label for use...track of source of the images be placed in said kit”.

In Claim 21, line 2, it is not understood what is meant by “the number of said image that to be scanned”.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 1 recites the limitation "the ordering" in line 3. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 21 recites the limitation "the number" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 23 recites the limitation "the same size" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-4, 8, 9, 11, 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims merely disclose a recitation of printed matter on a substrate which produces no useful, concrete and tangible result.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al (3,895,220).

Nelson discloses a kit comprising: an order form (12) for ordering goods; an instruction form (14) on how to use the kit and having a machine readable code (18) to obtain information; wherein the instructions are on a hard copy document with a visual format; and a envelope holder with a pocket (34).

However, Nelson et al does not disclose a kit for organizing a plurality of images; information for use in organizing the images; a holder for organizing the images; pockets for organizing the images.

In regards to **Claims 1, 5, and 6**, a recitation of the intended use (for organizing images) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many pockets in the envelope as desired for the

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purpose of holding more items, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

17. Claims 1-14, 16 and 21-23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Johnson et al (5,060,980) and Hicks (5,359,387).

Wentworth discloses in Fig. 1, a kit for organizing comprising various forms (Col. 3, lines 40-46) which can be placed in the kit; a hard copy instruction form document in visual format (as seen in Fig. 2); an envelope holder (12) which can include pockets (Col. 3, lines 51-53); and a container (11) having other sections for holding other formats such as cards.

However, Wentworth does not disclose: a kit for organizing images; an instruction form having a code capable of being machine read so as to obtain information for use in organizing; instructions on how to use the kit; a holder and pocket for organizing images; an instruction associated with a unique order instruction, and information associated with the images; a container for holding images; wherein the code comprises a color for the instruction form; wherein the instruction form is the same size as the hard copy prints; and a tool for use in determining the number of the image to be scanned.

Hicks discloses in Fig. 2, an order form (14) for ordering goods (26), wherein the order can be read by a tool (computer data base and reading device, as stated in Col. 4, lines 5-26).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an order form as taught by Hicks for the purpose of ordering items desired by the end user.

However, Wentworth as modified by Hicks does not disclose an instruction form having a code so as to obtain information; instructions on how to use the kit; an instruction associated with a unique instruction, and information associated with the images; a holder and pockets for organizing images; a container for holding images; wherein the code comprises a color for the instruction form; and wherein the instruction form is the same size as the hard copy prints.

Johnson et al discloses in Fig. 1, a form which can comprise instructions (Col. 6, lines 5-8 and 15-18), machine readable code (26) which can be in the form of an icon (Col. 4, lines 62-64), and human readable indicia (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an instruction form having encoded indicia as taught by Johnson et al for the purpose of informing the end user.

In regards to **Claims 1, 2, 5, 6, 8, 9, 12-14 and 21**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

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prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the kit of Wentworth is capable for organizing a plurality of images.

In regards to **Claim 9 and 10**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desired instructional information, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

In regards to **Claim 22**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

In regards to **Claim 23**, it would have been an obvious matter of design choice to construct the instruction form in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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18. Claim 15, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Johnson et al (5,060,980) and Hicks (5,359,387), and further in view of Schwandt (5,641,182).

Wentworth as modified by Johnson et al and Hicks discloses a kit comprising all the elements as claimed in claim 1, and as set forth above. Wentworth further discloses a legend (Fig. 2) and tabbed divider labels (Fig. 1).

However, Wentworth does not disclose a pair of identical labels for use in keeping track of source of the images to be placed in the kit.

Schwandt discloses in Fig. 3, a pair of labels (30 and 32) having identical indicia (37, Col. 5, lines 37-41), wherein one label (30) is placed on the holders as tabs, and the other label (32) is placed on the legend form (or central index).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include a pair of identical labels as taught by Schwandt for determining location of inserted articles in holders.

In regards to **Claim 15**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Therefore, the labels of Wentworth as modified by Schwandt are capable for use in keeping track of source of images placed in the kit.

19. Claim 17-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Johnson et al (5,060,980) and Hicks (5,359,387), and further in view of Kawai et al (6,043,866).

Wentworth as modified by Johnson et al and Hicks discloses a kit comprising all the elements as claimed in claim 1, and as set forth above.

However, Wentworth does not disclose carrier for holding an imaged sheet for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises an adhesive layer, alignment marks, and a retaining member.

Kawai et al discloses in Fig. 5, a carrier for holding an imaged sheet (G) for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises and adhesive layer (4), alignment marks (2a) for assisting in positioning, and a retaining member (3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include a carrier form as taught by Kawai et al for the purpose of protecting an original imaged sheet from being ruined by a scanning device.

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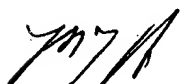
***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Kodama, Piotroski, Best et al, Thorne et al, Farnum discloses a carrier sheet. Hutzal, Nelson et al ('210), Badar, Yamamoto, Otake et al, Hammond, Winter et al, Dunn, Schluger, Policht, Bardeen, Capozzi et al, (EP- '616), Capozzi et al (EP- '503), McIntyre et al, Horn, Slater et al, Iguchi et al, Slater et al ('570), Schuffstall, Allen et al, Capozzi et al (JP- 104), Capozzi et al (JP - '008), Allen et al ('189), and Schluger ('464) disclose kits.

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### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 7, 2003

**A. L. WELLINGTON**  
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